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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,805	02/24/2004	Yoshinobu Imoto	040894-7000	1179
9629 7590 10/04/2010 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER ADEGEYE, OLUWASEUN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/784,805

**Applicant(s)**

IMOTO, YOSHINOBU

**Examiner**

OLUWASEUN A. ADEGEYE

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/21/2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 - 13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 07/19/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SI/22)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 2, 6, and 10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112 6th paragraph***

Claims 1 – 3 and 5 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph because it passes the 3-prong test and therefore shall be construed to cover the corresponding structure described in the specification and equivalents thereof.

"Reading means for" is considered to read on reading part (3), "decoding means for" is considered to read on first decoding part (5), "video signal output means for" is considered to read on reproduction part (8), "reading stop means for" is considered to read on reading part (3).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Um et al (US 2003/0118327 A1) in view of Ito et al (US 6,937,356 B1), St. Pierre (US 6,853,841 B1) and Anderson et al (US 5,349,348).

As to **claim 10**, Um discloses an optical disk reproducing apparatus comprising:  
a reading unit (fig. 2, 38) that reads image data recorded on an optical disk (see [38], [39] and fig. 2. "..... the controller 19 controls the DVR decoding DSP 38 and the parser 37 to reproduce that dubbed audio file as well."- [040]);

a first decoding unit (fig. 2, 34, 35) that decodes moving image data (see [38].  
The above paragraph discloses a movie audio decoder as well as a movie video decoder);

a second decoding unit (fig. 2, 32, 33) that decodes still image file including still image data (see [39]. The above paragraph discloses a still video decoder as well as a still audio decoder);

a switching unit (fig. 2, 37) that receives the image data from the reading unit, outputs the image data to the first decoding unit when the image data is the moving data, and outputs the image data to the second decoding unit when the image data is the still image data (see [38], [39] and fig. 2. Fig. 2 shows the parser sending the still picture and the movie to two separate decoders.);

a video signal output unit (fig. 2, 30, 31) that is connected to the first decoding unit and the second decoding unit and outputs a reproduction video signal of the image data decoded by the first decoding unit or by the second decoding unit (see [38], [39] and fig. 2. "The output switching units 30 and 31 .....select signals from the movie video 34 and the movie audio decoder 35 to output"- [038]);

Um also discloses a controller (19) but does not disclose

a header analysis unit that is disposed between the switching unit and the second decoding unit and analyzes a header of the still image file;

a control unit that determines whether or not an extension of the still image file is a predetermined extension; wherein when the control unit determines that extension of the still image file is the predetermined extension, the header analysis unit analyzes the header of the still image file and determines whether or not the still image file is a still image file that is decodable; and

reading of the still image file by the reading unit is stopped when the header analysis unit determines that the still image file is a still image file that is not decodable.

Ito discloses a header analysis unit (fig. 15, 621) that analyzes a header of the still image file (see column 16, lines 15 – 18, column 17, lines 3 – 7 and column 17, lines 46 – 51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the header analysis unit taught by Ito to the apparatus of Um so that pictures can be processed even during a print, display, transmission or viewing of the pictures (see column 5, lines 43 – 50).

Um in view of Ito does not disclose a control unit that determines whether or not an extension of the still image file is a predetermined extension; wherein when the control unit determines that extension of the still image file is the predetermined extension, the header analysis unit analyzes the header of the still image file and determines whether or not the still image file is a still image file that is decodable; and

reading of the still image file by the reading unit is stopped when the header analysis unit determines that the still image file is a still image file that is not decodable.

St. Pierre discloses a header analysis unit that determines whether or not the still image file is a still image file that is decodable (see column 6, line 64 – column 7, line 13. The above cited column discloses not being able to decode a requested format when the device supports a different format).

St. Pierre discloses reading of the still image file by the reading unit is stopped when the header analysis unit determines that the still image file is a still image file that is not decodable (see column 6, line 64 – column 7, line 13. The above cited column discloses sending out an error message (not decodable) when the network attached device cannot decode the requested image because the device does not support the format of the requested image.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the determining step of St. Pierre to the apparatus of Um in view of Ito to provide a system that is capable of being able to decode still pictures only of the format of the attached device.

Um in view of Ito and St. Pierre does not disclose wherein the second determination means is configured to determine that the still image file is the still image file that is compressed in the decodable format to the body, when a marker indicating that the still image file is a file of a progressive JPEG format is not present in a range from a marker indicating an image start to a marker indicating a scan start with of the inputted header, and in a case that a code indicating the JPEG format is not present.

Anderson discloses wherein the second determination means is configured to determine that the still image file is the still image file that is compressed in the decodable format to the body, when a marker indicating that the still image file is a file of a progressive JPEG format is not present in a range from a marker indicating an image start (SOI (start-of-image)) (see column 4, lines 3 – 4) to a marker indicating a scan start (SOS (start of scan)) (see column 4, lines 32 – 33) with of the inputted header (see column 1, lines 55 – 59), and in a case that a code indicating the JPEG format is not present (column 4, lines 51 – 53 discloses that if no valid marker is found where one was expected, the system stops processing the input data stream). Column 4, lines 54 - 61 also discloses that the parser interprets the information in the SOS marker segment to determine the precise operation to be performed e.g. PROGRESSIVE coding and calls the encoder/decoder subsystem, providing it with the information extracted from the various marker segments that have been interpreted. Column 5, lines 10 - 15 also discloses progressive JPEG.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the function of analyzing the markers in the still image file as taught by Anderson to the apparatus of Um in view of Ito and St. Pierre to arrive at an apparatus that is capable of analyzing the header of a still image file and able to determine the precise operation to be performed depending on what is detected in the SOS marker segment (see column 4, lines 54 - 61).

As to **claim 2** grounds for rejecting claim 10 apply to claim 2 in its entirety.

As to **claim 1**, this claim differs from claim 2 only in that the limitation "wherein the video signal output means outputs a predetermined video signal when the determination means determines that the still image file is the still image file that is not decodable in the body" is additionally recited.

St. Pierre discloses wherein the video signal output means outputs a predetermined video signal when the determination means determines that the still image file is the still image file that is not decodable in the body (see column 7, line 3. The above column discloses an error message if not decodable).

As to **claim 6**, grounds for rejecting claim 2 apply to claim 6 in its entirety.

As to **claim 3**, Um in view of Ito and St. Pierre disclose the optical disk reproducing apparatus as claimed in claim 2.

St. Pierre discloses the video signal output means outputs a predetermined video signal when the determination means determines that the still image file is the still image file that is not decodable in the body (see column 7, line 3. The above column discloses an error message if not decodable).

As to **claim 4**, Um in view of Ito and St. Pierre discloses the optical disk reproducing apparatus as claimed in claim 2. Ito discloses wherein the predetermined extension is JPG (see column 17, lines 3 – 7 and column 21, lines 38 – 42). See motivation statement above.

As to **claim 5**, Um in view of Ito and St. Pierre discloses the optical disk reproducing apparatus as claimed in claim 2. Um discloses wherein the decoding



means has a function of decoding moving image data compressed in MPEG2 (see [47]).

As to **claim 7**, grounds for rejecting claim 3 apply to claim 7 in its entirety.

As to **claim 8**, grounds for rejecting claim 4 apply to claim 8 in its entirety.

As to **claim 9**, grounds for rejecting claim 5 apply to claim 9 in its entirety.

As to **claim 11**, grounds for rejecting claim 3 apply to claim 11 in its entirety.

As to **claim 12**, grounds for rejecting claim 4 apply to claim 12 in its entirety.

As to **claim 13**, grounds for rejecting claim 5 apply to claim 13 in its entirety.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLUWASEUN A. ADEGEYE whose telephone number is (571)270-1711. The examiner can normally be reached on Monday - Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

09/29/2010

/O.A/

/Peter-Anthony Pappas/  
Supervisory Patent Examiner, Art Unit 2621